

REMARKS/ARGUMENTS

This is in response to the Final Office action of July 24, 2008. This response is being filed within the two-month period set for response so as to invoke an Advisory Action. Reconsideration is respectfully requested.

As a preliminary matter, the Applicants have removed the word “a” preceding the word “an” in claim 9. Reconsideration of claim 9 in view of this correction of a minor informality is respectfully requested.

Claims 1-4, 8-10 and 12 currently stand rejected under 35 U.S.C. 103(a) as being unpatentable over Kim (U.S. Patent No. 4,445,990) in view of Carlson (U.S. Patent No. 3,650,925). The Applicants respectfully traverse the Examiner’s rejection.

In stating the rejection, the Examiner states, inter alia, that “Kim ... does not disclose that the metal and the cathode are used as a source of metal to be deposited in a plating process.” Further, the Examiner states “[T]he Carlson Patent is cited to show the recovery of metal deposited onto a cathode by using the cathode as an anode to dissolve the metal into an electroplating process”. The Examiner then concludes that it would have been obvious “to modify the disclosure of the Kim patent with the teachings of the Carlson patent, because the Carlson patent teaches that conventionally the metal deposited upon a cathode is removed by reversal of polarity to form an anode to re-dissolve the metal into an electroplating solution.”

Independent claims 1, 11 and 12, by contrast, each claim “using the recovered deposit metal on the metallic cathode and the metallic cathode as a source of metal to be deposited on to a substrate in a subsequent metal plating process.” To establish a rejection under the 35 U.S.C. 103(a), as stated in MPEP 2143, the Examiner is required to articulate “(1) a finding that the prior art included each element claimed, although not necessarily in a single prior art reference, with the only difference between the claimed invention and the prior art being the lack of actual combination of the elements in a single prior art reference”. (Emphasis added) Nowhere in Kim, nor Carlson, nor the combination thereof, does it specifically describe a substrate, much less using the recovered deposited metal on the metallic cathode and the metallic cathode as a source of metal to be deposited on to a substrate in a subsequent metal plating process. Given that the proposed combination of Kim and Carlson does not disclose each element claimed in claims 1-4, 8-10 and 12, the Examiner has not stated a *prima facie* case of obviousness, and the rejection must be overturned. Reconsideration of claims 1-4, 8-10 and 12 is thus respectfully requested.

In addition, with respect to claim 8, neither Kim nor Carlson, alone or in combination, disclose “wherein the deposited metal on the cathodes is fractured into pieces and is used a source of metal ions in an electrochemical deposition of the metal.” For this additional reason, claim 8 is not obviated by the combination of Kim and Carlson. Reconsideration of claim 8 for this additional reason is respectfully requested.

Claims 5-7 and 11 currently stand rejected under 35 U.S.C. 103(a) as being

unpatentable over Kim (U.S. Patent No. 4,445,990) in view of Carlson (U.S. Patent No. 3,650,925) and further in view of de Nora et al. (U.S. Patent No. 4,834,850) for reasons of record. The Applicants respectfully traverse the Examiner's rejection.

As stated above, Kim, nor Carlson, nor the combination thereof, does it specifically claim a substrate, much less using the recovered deposited metal on the metallic cathode and the metallic cathode as a source of metal to be deposited on to a substrate in a subsequent metal plating process. de Nora, for reasons of record cited by the Examiner from the previous Office Action, was cited "to show the use of a similar range of pores per inch used in the reclamation of metal ions from wastewater". Thus, de Nora, like Kim and Carlson, does not describe a substrate, much less using the recovered deposited metal on the metallic cathode and the metallic cathode as a source of metal to be deposited on to a substrate in a subsequent metal plating process. Given that the proposed combination of references does not disclose each element claimed in claims 5-7 and 11, the Examiner has not stated a *prima facie* case of obviousness, and the rejection must be overturned. Reconsideration of claims 5-7 and 11 is thus respectfully requested.

In addition, with respect to claim 11, neither Kim nor Carlson, alone or in combination, disclose "wherein the deposited metal on the cathodes is fractured into pieces and is used a source of metal ions in an electrochemical deposition of the metal." For this additional reason, claim 11 is not obviated by the combination of Kim and Carlson. Reconsideration of claim 11 for this additional reason is respectfully requested.

In view of the above comments, it would appear that the application is conditioned for allowance and a notification of allowance is respectfully requested. Should the examiner have any questions with respect to the application and /or of this amendment, he may contact the undersigned by calling collect.

It is not believed that any new fees are necessitated by the entry of this amendment. However in the event that any new fees or charges are required, authorization is hereby given to charge such fees to applicant's Deposit Account No 50-0852.

Respectfully submitted,

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